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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/797,346 | 03/10/2004 | Niu Dong | 0109.03 | 4296 |
| 25278 7590 05/13/2011 USDA-ARS-OFFICE OF TECHNOLOGY TRANSFER PATENT ADVISORS OFFICE WESTERN REGIONAL RESEARCH CENTER 800 BUCHANAN ST ALBANY, CA 94710 | | | | |
| | | | EXAMINER | |
| | | | HAAS, WENDY C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1661 | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 05/13/2011 PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/797,346

Applicant(s)

DONG ET AL.

Examiner

WENDY C. HAAS

Art Unit

1661

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 1, 4, and 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 1-6 and 10-12 remain objected to because of the following informalities: claims 1, 4 and 10 are each missing a method step. Specifically, claims 1, 4 and 10 state that rooting is an optional step in the method. This does not clearly set forth a method step that results in an entire plantlet. "Plantlet" is a term of art. Please see the attached dictionary definition and art on Strawberries and potatoes – each of which reveals that a plantlet is a small complete plant, thus necessarily containing roots. Claims 2 and 3 depend from Claim 1; Claims 5 and 6 depend from Claim 4; and Claims 11 and 12 depend from Claim 10. Appropriate correction is required.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Wood. Wood teaches that the claimed method was invented, used and publicly disclosed by applicant as early as May of 1999. See the top of the second column on page 19.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood in view of Jorgensen (United States Plant Patent Number 5,180,873), Castillon et al. and Pan et al.

The teaching of Wood is set forth above.

Wood does not teach the use of selectable media, or particular light conditions.

Castillon et al. and Pan et al. teach Guayule transformation and tissue culture techniques and show these are known in the art, but do not teach use of leaf strips as an explant.

Jorgensen teaches that Agrobacterium transformation of leaf explants is known in the plant art as is tissue culture from leaf explants.

The Wood article notes that applicants based the claimed technique on known prior art techniques from other species and expressed that the motivation for using the leaf explant transformation technique was "we get more genetically engineered guayule plants than with an earlier, more cumbersome procedure." Ease of use and increased production motivated applicants.

As such, the invention was *prima facie* obvious at the time it was made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WENDY C. HAAS whose telephone number is (571)272-0976. The examiner can normally be reached on 7:30 - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Grunberg can be reached on (571)272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WENDY C HAAS
Primary Examiner
Art Unit 1661

/WENDY C HAAS/
Primary Examiner, Art Unit 1661